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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/072,071

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Jens Erik Sorensen

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10/20/2006

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,071

Applicant(s)

SORENSEN ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This is in response to the applicant's communication filed on June 30, 2006, wherein:

Claims 68-91 are currently pending;

Claims 1-67 have been cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 68-91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant has amended the claims to add in the following limitation:

providing at least one of the contractual rights from at least one of the contributors/owners or from at least one of the parties specified by the at least one contributor to at least one other party

It is not clear what the applicant is claiming in this step. For purpose of examination, the Examiner will interpret this as being a sublicense.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 68-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell (US 2004/00220881) (hereinafter referred to as Powell) in view of Erbisch, F. H., and Maredia, K. M., *Intellectual Property Rights in Agricultural Biotechnology*, published by CAB International in 1998 (hereinafter referred to as Erbisch).

Referring to Claims 68 and 81:

Powell discloses a computerized method and medium for managing ideas, the method comprising:

(a) accumulating idea contributions for prospectively patentable inventions in a computer database (Figure 2 (260, 261) [0111-0112]);

(b) providing contractual rights to contributors of the idea contributions or to parties specified by the contributors, in exchange for property rights to prospectively patentable inventions derived at least in part from the accumulated idea contributions, or in exchange for contractual obligations by the contributors to provide the property rights, wherein the contractual rights are to a portion of income associated with the property rights [0082] royalty.

Powell does not disclose providing at least one of the contractual rights from at least one of the contributors or from at least one of the parties specified by the at least one contributor to at least one other party (For examination purpose the Examiner is interpreting this as a sublicense).

However, Erbisch discloses providing at least one of the contractual rights from at least one of the contributors or from at least one of the parties specified by the at least one contributor to at least one other party (page 34, paragraph 3).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the idea submission and transfer method and medium of Powell the ability to transfer rights to at least one other party so that others can practice or use, make and/or sell the invention in different geographical regions with resections that each can only sell, make or use the invention in their respective regions.

Referring to Claim 69:

Erbisch discloses providing at least one of the contractual rights from an owner of the at least one of the contractual rights to at least one other party than the owner (pages 32-34, see page 34 paragraph 3 sublicense).

Referring to Claims 70, 78, 82 and 87:

Powell discloses marketing at least some of the contractual rights on-line (*the toy company is paying the originator for the first opportunity to bring the idea to market and obtain exclusive marketing rights to the initial product and **derivatives thereof** [0082]; [0015] users desiring to commercially exploit or otherwise utilize the originator's fully disclosed idea will negotiate directly for an exclusive or nonexclusive license, option, preemptive right or assignment of the idea utilizing electronically or web-enabled communication means) see also paragraph [0012] [0073] an Internet-based marketplace for ideas).*

Referring to Claims 79, 84 and 89:

Powell discloses wherein the marketable format is an electronically tradable certificate (*Black's Law Dictionary defines a certificate as a written assurance or official representation that some act has or has not been done or*

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*some event occurred, or come legal formality has been complied with, thus a license would be a certificate) ([0015] users desiring to commercially exploit or otherwise utilize the originator's fully disclosed idea will negotiate directly for an exclusive or nonexclusive license, option, preemptive right or assignment of the idea utilizing **electronically or web-enabled communication means**) see also page 3 [0024] and assignment or license can be transferred, page 14 [0016]).*

Referring to Claims 72, 85 and 90:

Powell discloses transferring, selling, and/or auctioning at least some of the contractual rights on-line ([0018] *an originator who desires to post, license or sell an idea, the system is an online commercial network [0012]*) see also page 3 [0024-0025]).

Referring to Claim 73:

Powell discloses wherein a computer system facilitates use of contributor computers to make on-line contributions of the idea contributions to the computer database [0012] [0018] [0073] [0091] [0111-0112]; and wherein the providing of contractual rights in (b) comprises providing the contractual rights to the portion of the income associated with the property rights by on-line communications between the computer system and the contributor computers ([0082] royalty).

Referring to Claims 74 and 80:

Powell discloses prior to filing any patent applications for any particular inventions derived at least in part from the accumulated idea contributions, publishing the accumulated idea contributions that the particular inventions are derived from [0013] granting user right to access [0018] the Examiner is

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considering posting as publishing [0082] [0100] granting user the right to access and consider the originator's fully disclosed idea; [0103] method and apparatus to post non-disclosing synopses of ideas; [0082] prior to reduction to practice (This is prior to a patent application being filed)).

Referring to Claim 75:

Powell discloses wherein the idea contributions include needs and/or requirements of the inventions [0012] [0016] [0093] [0098].

Referring to Claim 76:

Powell discloses wherein the marketing is on behalf of at least some assignees of the contractual rights [0073][0076] [0082].

Referring to Claims 77 and 86:

Powell discloses a computerized method and medium wherein idea contributions are accumulated for prospectively patentable inventions in a computer database (Figure 2 (260, 261) [0111-0112]), and wherein contractual rights are provided to contributors of the idea contributions or to parties specified by the contributors, in exchange for property rights to prospectively patentable inventions derived at least in part from the accumulated idea contributions, or in exchange for contractual obligations by the contributors to provide the property rights, wherein the contractual rights are to a portion of income associated with the property rights ([0082] royalty), comprising:

Powell does not disclose providing at least one of the contractual rights from at least one of the contributors or from at least one of the parties specified

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by the at least one contributor to at least one other party (For examination purpose the Examiner is interpreting this as a sublicense).

However, Erbisch discloses providing at least one of the contractual rights from at least one of the contributors or from at least one of the parties specified by the at least one contributor to at least one other party (page 34, paragraph 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the idea submission and transfer method and medium of Powell the ability to transfer rights to at least one other party so that others can practice or use, make and/or sell the invention in different geographical regions with resections that each can only sell, make or use the invention in their respective regions.

Referring to Claims 79, 83 and 88:

Powell discloses wherein the marketing is on behalf of at least some assignees of the contractual rights [0073][0076] [0082].

Referring to Claim 91:

Powell discloses wherein the marketing is of the provided contractual rights to a portion of income associated with the property rights ([0082] royalty).

Response to Arguments

Applicant's arguments filed June 30, 2006 have been fully considered but they are not persuasive.

The applicant argues that Powell does not disclose providing contractual rights from contributors or parties specified by contributors. Applicant states that Powell does not disclose providing contractual rights to parties other than

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contributors and that applicant recites the additional and very different act of providing contractual rights from contributors or parties specified by contributors to other parties.

The Examiner respectfully disagrees with this assertion and directs that applicant to paragraph [0162] wherein Powell discloses that a potential user may attempt to acquire from originator a license, preemptive right, assignment or other right to use the originator's FDI. Thus, the Examiner asserts that Powell discloses providing contractual rights **from** contributors/originators **to** other parties/users.

Applicant argues that Powell does not disclose the limitation of *prior to filing any patent applications for any particular inventions derived at least in part from the accumulated idea contribution, publishing the accumulated idea contributions that the particular inventions are derived from*. The applicant states that Powell does not disclose publishing prior to filing.

The Examiner respectfully disagrees with this assertion. MPEP 2111 states that claims must be give their broadest reasonable interpretation consistent with the supporting description without reading limitations into the claim.

Merriam Webster Online dictionary defines publishing as:

Main Entry: **pub·lish** ˈpʌ-lish

Pronunciation: 'p&-blish

Function: *verb*

Etymology: Middle English, modification of Anglo-French *publier*, from Latin *publicare*, from *publicus* public
transitive verb

1 a : to make generally known **b** : to make public

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announcement of

2 a : to disseminate to the public **b** : to produce or release for distribution; *specifically* : PRINT **2c c** : to issue the work of (an author)

intransitive verb

1 : to put out an edition

2 : to have one's work accepted for publication

- **pub·lish·able** *ˈbʌlɪʃəbəl* *adjective*

Thus, posting or disseminating or producing or releasing for distribution is publishing. Powell discloses posting of ideas over the Internet [0018] [0072-0073]. No application has been filed in Powell. Thus, Powell discloses publishing prior to filing.


As for the dependent claims, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jan Mooneyham
Primary Examiner
Art Unit 3629